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| 09/199,320      | 11/25/1998  | JOHANN KLEIN         | Q051986             | 3573             |

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

18

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/199,320

Applicant(s)

KLEIN, JOHANN

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,7,10 and 11 is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,8,9 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of **claims 2, 3, 5, 6, 8, 9, and 12-14** is withdrawn in view of the newly discovered reference(s) to Micheals et al (United States Patent 6,011,976). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 2, 5, 8, 9, and 12-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Micheals et al. (United States Patent 6,011,976), hereinafter referenced as Michaels.

Regarding **claim 5**, Michaels discloses a telecommunications system with value added service directory. In addition, Michaels discloses a process of transmitting a telephone number of a desired subscriber from a directory enquiry facility to a terminal connected to the directory enquiry facility over a telecommunication network with a first channel for voice transmission and a second channel for data transmission, the process consisting of:

transmitting an enquiry with the data describing the desired subscriber from the terminal to the directory enquiry facility on the first channel,

transmitting the telephone number in the form of a numeric string from the directory enquiry facility to the terminal on the second channel,

receiving the numeric string at the terminal,

determining the telephone number from the numeric string,

storing the telephone number in a memory in the terminal provided for direct dialing of telephone numbers, as disclosed at column 4, lines 12-53 ,

where the telecommunication network is a GSM mobile telephone network and the second channel is an organization channel of the mobile telephone, as disclosed at column 3, line 1 through column 4, line 11 and exhibited in figure 1.

Regarding **claim 2**, Michaels discloses everything claimed as applied above (see claim 5), in addition Michaels discloses whereby the directory enquiry facility also issues an action command that causes the terminal to determine the telephone number from the numeric string and to save the telephone number in the memory in the terminal provided for direct dialing of telephone numbers

Regarding **claim 8, 9 and 12-14** Michaels discloses everything claimed. In addition, claims 8, 9 and 12-14 are interpreted and thus rejected for the reasons set forth above in the rejection of claims 5 and 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. ***Claims 3 and 6*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaels in view of Yablon.

Regarding **claim 3**, Michael discloses everything claimed as applied above (see claim 5), however, Michael fails to disclose where by the telephone number is displayed on a display in the terminal. However, the examiner maintains that it was well known in the art to provide whereby the telephone number is displayed on a display in the terminal, as taught by Yablon.

In addition, Yablon discloses whereby the telephone number is displayed on a display in the user's telephone, as disclosed at column 11, line 65 through column 12, line 12 and exhibited in figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Michaels by specifically providing whereby the telephone number is displayed on a display in the terminal, as taught by Yablon, for the purpose of providing visual indication of the stored telephone number.

Regarding **claim 6**, Michael discloses everything claimed as applied above (see claim 5), however, Michael fails to disclose whereby the directory enquiry facility sends the data describing the desired subscriber as an alpha-numeric string, and the terminal

receives the alpha-numeric string, derives the data from the alpha-numeric string, and displays in on a display. However, the examiner maintains that it was well known in the art to provide whereby the directory enquiry facility sends the data describing the desired subscriber as an alpha-numeric string, and the terminal receives the alpha-numeric string, derives the data from the alpha-numeric string, and displays in on a display, as taught by Yablon.

In addition, Yablon discloses whereby the directory assistance operator sends the character string, which reads on "data describing the desired subscriber as an alpha-numeric string", to the user's telephone on the second channel, the user's telephone number receives the character string, derives the data from the character string, and displays it on the display, as disclosed at column 11, line 65 through column 12, line 9; column 12, lines 52-68 and column 15, line 50 through column 16, line 2 and exhibited in figures 1-4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Michaels by specifically providing whereby the directory enquiry facility sends the data describing the desired subscriber as an alpha-numeric string, and the terminal receives the alpha-numeric string, derives the data from the alpha-numeric string, and displays in on a display, as taught by Yablon, for the purpose of providing both name and telephone number for the requested information.

***Allowable Subject Matter***

4. ***Claims 4, 7, 10 and 11*** are allowed.
5. The following is an examiner's statement of reasons for allowance:

Regarding **claim 7**, the prior art of record failed to disclose or fairly suggest wherein a key is pressed on the key board of the terminal it sends a message to the directory enquiry facility on the second channel, indicating to the directory enquiry facility a request for further information.

Regarding **claim 10**, the prior art of record failed to disclose or fairly suggest wherein a key is pressed on the key board of the terminal it sends a message to the directory enquiry facility on the second channel, indicating to the directory enquiry facility a request for further information.

Regarding **claim 11**, the prior art of record failed to disclose or fairly suggest wherein a key is pressed on the key board of the terminal it sends a message to the directory enquiry facility on the second channel, indicating to the directory enquiry facility a request for further information.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JFH  
October 21, 2003



XU MEI  
PRIMARY EXAMINER